REMARKS

Reconsideration of the instant application is respectfully submitted. The present amendment is submitted in response to the Office Action dated June 17, 2004 in which claims 1-45 are pending. Claims 1-17, 21-39, and 43-45 stand rejected. Claims 18-20 and 40-42 have been objected to by the Examiner as being dependent upon rejected based claims. The Applicants request reconsideration of the outstanding rejections in view of the arguments presented herein.

Claim Rejections under 35 USC §102(e)

Claims 1-6, 10, 16-17, 21-28, 32, 38-39, and 43-45 have been rejected under 35 USC 102(e) as being allegedly anticipated by U.S. Patent No. 6,453,353 to Win et al (hereinafter Win). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the * * * claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988).

Moreover, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985). The Applicants' traverse the rejections based upon Win because Win does not teach or disclose each of the claimed elements of the invention as provided

in Applicants' claims 1-6, 10, 16-17, 21-28, 32, 38-39, and 43-45.

Moreover, a prior reference is valid as prior art only for what it enables. "In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'... ." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968).

Specifically, with respect to claims 1 and 23, Win does not teach or suggest "receiving a request for a data file from a requester;...[and] displaying at least one available data format selected from a list of stored data formats, said at least one available data format selectable by said requester." Rather, Win teaches a system for controlling access to resources on a network. The resources are not explicitly defined in the Win reference, however, by implication the resources appear to be documents, applications, and/or reports (FIG. 10A, Employee Benefits 1108a, National Sales Reports 1108b, and Order Tracking System 1108n), access to which are controlled via assigned user roles. The Examiner appears to be equating the resources taught by Win with the data formats recited in the applicants' claims. In this regard, the Applicants respectfully submit that the Examiner has misapplied Win in his assertion that "FIG. 10A illustrates different data formats that are potentially selectable by a document requester..." (Office Action of June 17, 2004, Page 2). There is no teaching or suggestion in the Win reference that these resources refer to data formats, but rather appear to reference documents, applications, and/or reports as indicated above. In contrast to the resources taught by Win, data formats, as is well known in the art (and as applied to the Applicants claims), refer to a standardized means of presenting data and does not refer to the data itself. In support, the Applicants kindly direct the Examiner's attention to http://www.webopedia.com/quick_ref/fileextensionsfull.asp for a listing of file extensions used to differentiate and specify the various types of data formats existing in the art. Support may also be found directly within the Applicants' specification. Thus, the resources taught by Win are not synonymous with the data formats. Accordingly, Win does not teach or suggest "receiving a request for a data file from a requester;...[and] displaying at least one available data format selected from a list of stored data formats, said at least one available data format selectable by said requester." The Applicants submit, therefore, that Win does not teach or suggest each and every

element of Applicants' claims 1 and 23 and that claims 1 and 23 are patentable over Win. Applicants' submit that claims 1 and 23 are in condition for allowance for at least these reasons.

Claims 2-22 depend from claim 1 and claims 24-44 depend from claim 21. For at least the foregoing reasons, claims 2-22 and 24-44 are in condition for allowance. The Applicants further submit that claim 45 is in condition for allowance for at least the reasons provided above with respect to claims 1 and 23.

Claim Rejections under 35 USC §103(a)

The Examiner has rejected claims 7-9, 11-15, 29-31, and 33-37 under 35 USC 103(a) as being unpatentable over Win. The Applicants respectfully disagree. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness. *In re Fine*, U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicants' claims 7 and 29 recite "said translated data file is retained at a response repository outside of said firewall for a predetermined time period." The translated data file refers to a data file translated based upon a requester-selected data format provided by the invention. The translated data file in the Win reference does not result from a user-selected data format request but from a network standard (e.g., HTML) (col. 11, line 38). Thus, the translated data files of the instant application are not synonymous with the translated documents in the Win reference. Accordingly, it would not have been obvious to one of ordinary skill in the art to modify Win to

include this feature. For at least this reason, claims 7 and 29 are not obvious over Win. Assuming for the sake of argument, that claims 7 and 29 may be construed as obvious over Win, it does not cure the deficiencies stated above, namely, that claims 1 and 23, respectively, are not anticipated by Win. As claim 7 is dependent upon claim 1, and claim 29 is dependent upon claim 23, the Applicants further submit that claims 7 and 29 are in condition for allowance. Reconsideration of the rejections is respectfully requested. Moreover, the Applicants' submit that claims 8, 9, 11-15, 30, 31, and 33-37 are allowable for at least the reasons given above with respect to claims 7 and 29.

Conclusion

No new matter has been entered and no additional fees are believed to be required. However, if any fees are due with respect to this Amendment, please charge them to Deposit Account No. 50-0510 maintained by Applicants' attorneys.

Respectfully submitted,

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